

Patent Application Serial No. 10/633,898
Inventor: Sheng-Bin

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REMARKS

Applicant appreciates the attention of the Examiner to the application. The Office Action of the Examiner of September 30, 2004 has been reviewed with care in the preparation of this response. The amendment above and the following remarks are believed to be fully responsive to this action.

Status of Claims

Claims 1-19, as presented by the above amendment, are pending. The pending claims set forth a novel and non-obvious erectable/collapsible soft storage container. Allowance of all pending claims is respectfully requested in view of the above amendment and the following remarks.

Claims 1-9 and 12-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Katz (U.S. Patent No. 3,708,045) in view of Birkestrand (U.S. Patent No. 6,244,399). Claims 10 and 11 were rejected as being unpatentable under 35 U.S.C. §103(a) over Katz in view of Birkestrand, and further in view of Haddock (U.S. Patent No. 4,716,947).

Applicant thanks the Examiner for the telephonic interview with counsel on December 9, 2004. A discussion was held during this interview regarding a proposed amendment to certain of the pending claims and in particular to claim 1. Following the favorable comments of the Examiner and his suggestions regarding further amendment of claim 1 to more clearly define the invention over the prior art, Applicant has prepared and hereby submits the above amendment.

Claims 1, 5, 11, 15, 16 and 17 have been amended. Claims 18 and 19 have been added. The proposed amendment is fully supported by the specification to the application and does not include any new matter. The claims as amended are not rendered unpatentable by the references cited but are instead patentably distinguishable over such prior art.

Applicant now turns to the particular points raised by the Examiner in the Office Action of September 30, 2004 as they pertain to pending claims 1-19.

Rejection of Claim 1 under 35 U.S.C. §103(a)

Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Katz in view of Birkestrand. Claims 2-19 are dependent to claim 1.

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Obviousness under 35 U.S.C. §103(a) can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Jones, 958 F.2d 347 (Fed. Cir. 1992). In addition, any such combination or modification of the prior art must still teach or suggest each and every one of the claim limitations. MPEP §2143. The references cited by the Examiner, however, fail to teach or suggest all of the limitations set forth in amended claim 1.

Claim 1, as amended, is directed to an erectable/collapsible container having at least three of its four sidewalls embedded with a single hard board and where each sidewall has a top and bottom edge. Moreover, the open top to the container is defined by these top edges and the container's bottom is opposite the top. The bottom includes two flaps where each flap has a first bottom-flap edge and a second bottom-flap edge, each of these edges being attached with respect to the bottom edge of a different sidewall.

None of the references cited by the Examiner, alone or in combination, disclose a collapsible container having a body of flexible material forming sidewalls where even one of the sidewalls, much less at least three, has embedded within it only one hard board. Katz is not collapsible and teaches only reinforcing strips 17 stitched around the edge portions at the ends of the luggage bag and to the top and bottom surfaces (column 2 at line 64 to column 3 at line 4).

Likewise, Birkestrand teaches a luggage case having top, bottom and opposite sidewalls formed from a loop of material incorporating a multiplicity of narrow slats 12 spaced apart from one another along its length (column 2, lines 56-66). As a result, each of these walls has multiple slats stitched within it. In addition, the case in Birkestrand includes front and rear panels that have two struts 42 extending between opposite corners of each panel in a cross-like manner to stiffen the panel (column 3, lines 37-43). These struts are not embedded but releasably secured to the panels since they must be removed from the panels in order to collapse the case (column 3, lines 43-47).

Given the absence as well of any teaching or suggestion in either of these references that is directed to a modified container having at least three sidewalls made from flexible material

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with one hard board embedded in each wall, the combination of Katz and Birkestrand fails to disclose every limitation set forth in amended claim 1.

Moreover, neither Katz nor Birkestrand disclose a collapsible container having an open top and a bottom opposite from the top with two flaps that can be engaged together with an edge-fastener. When the luggage bag in Katz is unzipped, the sidewall opposite the opening is fully closed. In addition, two bottom flaps are not shown in Katz having a first edge, a second edge and a diagonal-edge. Each of the two flaps in Katz has a continuous, curved interior edge attaching the flap to the bag and a non-diagonally curved exterior edge. Not only does each flap have only two edges but neither interior edge is attached to the bag at the bottom edge of opposite sidewalls. The case in Birkestrand is missing not only an open top but also a bottom formed from two engageable flaps.

Even if arguably Birkestrand did disclose features missing from Katz and together all of the limitations in amended claim 1 are met, there still must be more of a justification for combining the references cited than solely the fact that a particular combination of structural features happened to have been known at the time of the invention. An examiner may not select from the prior art the separate components of the claimed invention by simply using the blueprint supplied by the inventor. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F. 3d 1350 at 1357-1358; 47 USPQ 2d 1453 (Fed. Cir. 1998).

In the Office Action, there is no showing of any motivation in the prior art for the application of Birkestrand to Katz. The Examiner makes reference only to how "it would have been obvious to employ the hard boards of Birkestrand in the bag of Katz to provide better

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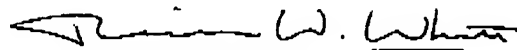
protection for the contents of the bag.” Such modification of the bag in Katz would be inconsistent with its critical feature, namely the path of the zipper 18 is to extend across the surface of sidewall 12 and endwalls 14, 15 (FIGS. 1-3). Hard boards in one or more of these walls would make such a feature very difficult. If a proposed combination would change the principle of operation of the prior art being modified, the teachings of the references are then not sufficient to render the claims prima facie obvious. MPEP §2143.01.

For each of the reasons discussed above, claim 1 as amended overcomes its rejection under 35 U.S.C. §103(a) in the Office Action. Applicant respectfully asks that the rejection of claim 1, in addition to each of the claims that are dependent to it, be withdrawn and that these claims be allowed.

Conclusion

Applicant's invention, as set forth in the amended claims, represents a highly desirable soft storage container. Applicant believes that the now pending claims 1-19 include essential features not disclosed or suggested in the prior art. Applicant submits that all rejections in the Office Action have been traversed by amendment and argument, placing the application in condition for allowance. Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned if such would be helpful in resolving any issue which might remain.

Respectfully submitted,



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Dated: December 29, 2004

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